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10/030,962	01/09/2002	John Kenneth Kirby	46309/268666	2786

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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT PAPER NUMBER

1772

DATE MAILED: 10/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding..

# Office Action Summary

Application No.

10/030,962

Applicant(s)

KIRBY, JOHN KENNETH

Examiner

Patricia L. Nordmeyer

Art Unit

1772

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-12 and 22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 and 22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 3/05
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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## **DETAILED ACTION**

### ***Withdrawn Rejection***

1. The 35 U.S.C. 112 2<sup>nd</sup> paragraph rejection of claims 1 – 12 and 22 is withdrawn due to Applicant's amendments and arguments in the paper dated May 3, 2005.

2. The 35 U.S.C. 103 rejection of claims 1 – 3, 7 – 9 and 22 over Bristol et al. in view of Scianna is withdrawn due to Applicant's amendments and arguments in the paper dated May 3, 2005.

3. The 35 U.S.C. 103 rejection of claims 4, 10 and 11 over Bristol et al. in view of Scianna and Ferrar et al. is withdrawn due to Applicant's amendments and arguments in the paper dated May 3, 2005.

4. The 35 U.S.C. 103 rejection of claims 5, 6 and 12 over Bristol et al. in view of Scianna and Higgs is withdrawn due to Applicant's amendments and arguments in the paper dated May 3, 2005.

### ***New Rejections***

#### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Art Unit: 1772

6. Claims 1 – 12 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “ the upper and lower planar layers each have the same construction to prevent distortion of the tile during moulding thereof” in claim 1 is unclear which renders the claim vague and indefinite. It is unclear from the specification and drawings what is meant the “same construction”. Are the layers the thickness or dimensions? The same material? If the “same construction” is suppose to related to the type of material, then claims 8 and 9 are unclear. How can the layers be of the same type of material when only one of the laminate has be a selected material?

Claims 2 – 12 and 22 are rejected under 35 U.S.C. 112 2<sup>nd</sup> paragraph due to their dependency on the above rejected claim.

Correction/clarification is required.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1772

8. Claims 1 – 4, 7 – 11 and 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol et al. (USPN 4,834,502) in view of Ferrar et al. (USPN 5,578,370).

Bristol et al. disclose a laminar mat suitable for use as a mouse mat (Column 1, lines 4 – 5) comprising a rigid planar tile of molded plastic material (Column 2, lines 46 – 51; Figure 2, #14) having upon respective upper and lower surfaces respective upper and lower planar layers (Figure 2, #12 and 16), where in the upper and lower planar layers are each a of a similar material (Column 2, lines 19 – 21; Column 2, lines 68 to Column 3, line 1 – wherein the layers are similar due to the fact they are both made from plastics material), the upper layer is textured (Column 2, lines 29 – 30) and the lower layer is provided with non-slip coating which resists the movement of the mat relative to a work surface (Column 2, lines 59 – 61) as in claims 1 and 2. With regard to claim 22, at least one of the planar layers includes a coating with anti-static properties (Column 2, lines 19 – 29). However, Bristol et al. fail to disclose the planar layers non-adhesively bonded therewith, the upper and lower layer each having the same construction to prevent distortion of the tile, the plastics material being polypropylene, oriented polypropylene or polyester and the planar layers are laminated.

Ferrar et al. teach a plastics material of oriented polypropylene (Column 2, lines 47 – 48), the upper and lower planar layers having the same construction to prevent distortion of the tile comprising three laminae and each of the three laminae being oriented polypropylene (Column 2, lines 52 – 55) wherein the layers are non-adhesively bonded therewith through molecular interspersions (Column 2, lines 23 – 28) for the purpose of having a composite material that has

Art Unit: 1772

mechanical strength in the direction of the plane of the fabric in general engineering applications (Column 1, lines 8 – 13).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided the oriented polypropylene layers in the modified Bristol et al. in order to have a composite material that has mechanical strength in the direction of the plane of the fabric in general engineering applications as taught by Ferrar et al.

The limitations of “by mould during moulding of the mat” and “with an external screen printed non-slip coating applied after moulding” in claim 1 are process limitations. The determination of patentability for a product claim with a process limitation is based on the product itself and not on the method of production. In this case, the limitation of molding the mat and coating applied after molding are methods of production and therefore do not determine the patentability of the product itself. The method of forming the product is not germane to the issue patentability of the product itself. MPEP 2113.

9. Claims 5, 6 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bristol et al. (USPN 4,834,502) in view of Ferrar et al. (USPN 5,578,370) as applied to claims 1 – 4, 7 – 11 and 22 above, and further in view of Higgs (GB 2,289,520).

Bristol et al., as modified with Ferrar et al., disclose a laminar mat suitable for use as a

Art Unit: 1772

mouse mat comprising a rigid planar tile of molded plastic material having upon respective upper and lower surfaces respective upper and lower planar layers, where in the upper and lower planar layers are each a of a similar material, the upper layer is textured and the lower layer is provided with non-slip coating which resists the movement of the mat relative to a work surface. However, the modified Bristol et al. fail to disclose the planar layers comprising paper, cardboard and a lamina of paper provided between the laminae of oriented polypropylene.

Higgs teaches planar layers comprising paper (Figure 3, #1) and cardboard (Figure 3, #2) in a mouse pad (Page 3, claim 1) for the purpose of providing a flat smooth surface that information can be printed onto the surface of the mouse pad (Page 2, lines 1 – 2).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided paper and cardboard in Bristol et al. in order to have a flat smooth surface that information can be printed onto the surface of the mouse pad as taught by Higgs.

The modified Bristol et al. disclose the claimed invention except for the planar layers each comprise a lamina of paper provided between the laminae of oriented polypropylene. It would have been obvious to one of ordinary skill in the art at the time the invention was made to place piece of paper between the laminae of the oriented polypropylene, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japikse*, 86 USPQ 70.

***Response to Arguments***

10. Applicant's arguments with respect to claims 1 – 12 and 22 have been considered but are moot in view of the new ground(s) of rejection.

***Conclusion***

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571) 272-1496. The examiner can normally be reached on Mon.-Thurs. from 7:00-4:30 & alternate Fridays.



Art Unit: 1772

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Y. Pyon can be reached on (571) 272-1498. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Patricia L. Nordmeyer  
Examiner  
Art Unit 1772

*pln*  
pln

*[Signature]*  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

*10/7/05*